

REMARKS

Applicant respectfully requests reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1-16 are *pending*. Claims 4-7 have previously *been withdrawn*. Claims 1, 8, and 11 are *independent*. Claims 1 and 8-11 have been *amended*; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1-3 and 8-16 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection.

Though Applicant respectfully traverses the Examiner's rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claims 1, 8 and 11 to provide clarification and/or to better track business practices. Accordingly, Applicant requests: withdrawal of this ground of rejection(s), and reconsideration and allowance of the claims.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-3 and 8-16 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP §2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection." MPEP §2106 also discusses "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be."

Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Though Applicant respectfully traverses the Examiner's rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claims 1, 8, and 11 to provide clarification and/or to better track business practices. Claim 1 is a "system to support a derivative transaction" and recites "a memory" and "a processor disposed in communication with said memory, and configured to issue a plurality of processing instructions stored in the memory, wherein the processor issues instructions to". Amended claim 11 recites, inter alia, a "processor implemented method" and "receiving by a processor" and claim 8 recites, inter alia, a "processor readable medium storing" and "receive data by a processor." Applicant submits claims 2-3, 9-10, and 12-16 which depend directly or indirectly from independent claims 1, 8, and 11 are directed to statutory subject matter for at least the reasons discussed above.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1, 8, and 11 are allegedly directed to non statutory subject matter. Accordingly, for at least these reasons, Applicant submits that claims 1-3 and 8-16 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claims 1-3 and 8-16 under 35 U.S.C. § 102(b) as anticipated by May, US Patent No. 6,317,727 (hereinafter "May"). Applicant respectfully traverses the rejection and submits that May does not discuss every element of the noted claims.

Some of the claim elements of independent claim 1 not found in May include:

- ...receive data identifying a reference entity participating in said derivative transaction;
- receive a template for screening said received data identifying said reference entity;
- screen said received data according to the received template identifying said reference entity for accuracy;

- ...
- identify a contractual relationship between said reference entity and said at least first reference obligation;
- assigning verification activities to users along with associated materials for facilitating a verification;
- output a data record associated with said derivative transaction, said data record including said data identifying said reference entity...

Applicant submits May does not discuss or render obvious at least these elements from independent claim 1. In the pending rejection, the examiner alleges, "May clearly sets forth in, for example, Col. 1 Lines 35-50, that automated systems provide for greater accuracy." (Office Action, February 4, 2009, page 3). The Office Action has cited Fig. 14A, col. 1 line 35-50, and col. 39, lines 36-40 in rejecting claim. (Office Action, February 4, 2009, pages 3-4). Applicant submits that it is unclear which claims limitations the Examiner is addressing in the rejection.

Applicant respectfully requests that the Examiner specifically indicate the claim elements being addressed substantively so that the Applicant can respond accordingly for each claim.

Further, Applicant submits that the rejections in the Office Actions dated July 8, 2008, and February 4, 2009, do not address every claim limitation to establish the differences in the claim over the applied references and over-generalizes cited references. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. The Examiner has failed to comply with this. Applicant respectfully requests that every claim limitation be considered and addressed.

Further, the Examiner attempts to address claim 1 but paraphrases and over-generalizes what is actually claimed in claim 1. The Examiner states:

"[A]nother way to look at the limitation "screening for accuracy" may be found within the input mechanism itself..."
(Office Action, February 4, 2009, page 4)

In contrast, claim 1 recites, *inter alia*:

...screen said received data according to the received template identifying said reference entity for accuracy...

screen said received data according to the received template identifying said at least a first reference obligation for accuracy...

Therefore, Applicant respectfully requests that the Examiner's rejection adhere to the language recited in the claims and discuss with particularity where and how the alleged anticipatory reference discusses each and every claim element. Otherwise, Applicant cannot be sure if, which, and/or to what claim limitations the rejection is addressing or asserting the reference anticipates. Applicant further requests the Examiner to substantively address all recited claim elements with particularity. Because

every limitation of claim 1 is not addressed in the pending rejection, Applicant submits claim 1 is patentably distinct over May. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of claim 1 is allegedly anticipated by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Furthermore, Applicant submits that neither Fig. 14A of May nor other cited portions, relied on by the Examiner disclose "identify a contractual relationship between said reference entity and said at least first reference obligation," or "receive a template for screening said received data identifying said reference entity," or "screen said received data according to the received template identifying said reference entity for accuracy," or "assign verification activities to users along with associated materials for facilitating a verification," as recited in claim 1. May simply discusses a credit monitoring system in an electronic trading system to determine if two counterparties can trade based on predefined credit preferences. For example, one cited portion of May, relied on by the Examiner states:

In recent years, commodity exchanges have become more and more dependent upon electronic trading systems. The older manual methods by which trades were conducted have given way to advanced computer systems that have generally mimicked the manual methods of old. These relatively new electronic trading systems have many advantages over the manual systems...
(May, col. 1, lines 35-50)

Another cited portion of May, relied on by the Examiner, states:

Once a portfolio is inputted, the user must confirm its accuracy by selecting the Apply button 381 before the positions can be used in the switch mechanism 35 of the central processing center 12 (FIG. 2).
(May, col. 39, lines 36-40)

May's general discussion of a credit monitoring in an electronic trading system does not disclose or suggest "identify a contractual relationship between said reference entity and said at least first reference obligation," or "receive a template for screening said received data identifying said reference entity," or "screen said received data according to the received template identifying said reference entity for accuracy," or "assign verification activities to users along with associated materials for facilitating a verification," as recited within the context of claim 1.

Because the pending rejection has not established a *prima facie* case of anticipation by neglecting claim elements and the cited reference does not discuss or anticipate at least the claim elements described above, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

Although of different scope than independent claim 1, Applicant submits that independent claims 8 and 11 are patentably distinct from May for at least similar reasons to those discussed above identifying deficiencies in the cited reference with respect to independent claim 1. Furthermore, Applicant submits that claims 2-3, 8-10 and 12-16 which depend directly or indirectly from independent claims 1, 8, and 11 are also patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those deficiencies discussed above in the cited references with respect to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections for these claims as well.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-3 and 8-16 under 35 U.S.C. § 103(a) as being unpatentable over May, US Patent No. 6,317,727 (hereinafter "May"), and in further view of Clark et al., US Patent No. 5,890,140 (hereinafter "Clark"). Applicant respectfully traverses the rejections.

Applicant submits that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination. MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements.

The Office Action states that "[I]f applicant is of the opinion that May does not disclose verifying or screening data for accuracy, then resort may be had to Clark et al. to show it is old and well known to do so at various points in a financial transaction sequence." (Office Action, February 4, 2009, p. 7). However, it is not clear from this rejection which deficiency in May the Examiner is allegedly curing by citing Clark. Applicant submits that it is unclear which claims limitations the Examiner is addressing in the rejection.

Further, Applicant submits that the pending rejection do not address every claim limitation to establish the differences in the claim over the applied references and over-generalizes cited references. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), *emphasis added*] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, *emphasis added*]. The Examiner has failed to comply with this and therefore has failed to establish a *prima facie* case of obviousness. Applicant respectfully requests, if the rejection is maintained, that every claim limitation be considered

and addressed. Applicant respectfully requests that the Examiner specifically indicate the claim elements being addressed substantively so that the Applicant can respond accordingly for each claim.

Further, MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicant contends that a *prima facie* case of obviousness has not been established, for reasons discussed above, but has provided the following discussion in an effort to provide clarification of the claim elements, expedite further prosecution, and to more accurately track Applicant's current practices.

Some of the claim elements of independent claim 1 not found in May or Clark, alone or in combination, include:

- ...receive data identifying a reference entity participating in said derivative transaction;
- receive a template for screening said received data identifying said reference entity;
- screen said received data according to the received template identifying said reference entity for accuracy;
- ...
- identify a contractual relationship between said reference entity and said at least first reference obligation;
- assigning verification activities to users along with associated materials for facilitating a verification;
- output a data record associated with said derivative transaction, said data record including said data identifying said reference entity...

The Office Action has cited col. 20, lines 7+ and figures 16, 18, and 19 of Clark in rejecting claim 1, specifically equating these elements to "verifying or screening data for accuracy." (Office Action, February 4, 2009, page 7). Instead of discussing the claimed elements in the cited passages, Clark simply discusses a system for communicating with a global electronic delivery system financial services that routes messages between customers at different geographical locations and in different time zones. Further, Clark's general discussion of communicating with a global electronic delivery

system does not disclose or suggest at least "identify a contractual relationship between said reference entity and said at least first reference obligation," or "receive a template for screening said received data identifying said reference entity," or "screen said received data according to the received template identifying said reference entity for accuracy," or "assign verification activities to users along with associated materials for facilitating a verification," as recited within the context of claim 1.

More specifically, Applicant submits that the Examiner's cited portions of Clark merely state:

FIG. 19 shows the flow processes of a user verifying and authorizing cash transactions after selecting the cash management application from the main window of FIG. 15. To authorize a transaction, the Authorize function is selected from the cash management window...A "sort by" box allows the user to sort the list of transactions by type, amount, reference, status, currency, or value date. To authorize a transaction or transactions, the user simply selects the transactions from the list of transactions awaiting authorization.

(Clark, col. 20, lines 7-17).

As such, the cited figures of Clark, relied on by the Examiner, merely illustrate steps for processing cash transactions. For example, figure 16 is a diagram showing the steps for processing a cash transaction at the customer facilities, figure 18 is a flow chart of a process for inputting a cash management instruction into the customer facility, and figure 19 is a flow chart of a process for verifying and authorizing a cash transaction. The mere mention of verification is not sufficient as it is explicit in Clark that cash transactions are simply verified for financial services provided at different geographical locations and in different time zones. Therefore, Clark or May, taken alone or in combination, among other limitations, do not disclose or suggest the claim elements as recited within the context of claim 1.

Although of different scope than independent claim 1, Applicant submits that independent claims 8 and 11 are patentably distinct from May for at least similar reasons to those discussed above

identifying deficiencies in the cited reference with respect to independent claim 1. Furthermore, Applicant submits that claims 2-3, 8-10 and 12-16 which depend directly or indirectly from independent claims 1, 8, and 11 are also patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those deficiencies discussed above in the cited references with respect to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections for these claims as well.

Conclusion

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-16, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not

meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209.340. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209.340.

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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